

### **THE OFFICE ACTION**

In the Office Action mailed November 3, 2005, the Examiner rejected claims 1, 3-10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Nos. 6,006,034 to Heath ("Heath"), in view of 5,019,963 to Alderson ("Alderson") and 5,692,111 to Marbry et al. ("Marbry").

Claim 2 was rejected under §103(a) as being unpatentable over Heath in view of Alderson, Marbry and further in view of U.S. Patent No. 5,742,829 to Davis et al. ("Davis"). Claim 11 was rejected under §103(a) as being unpatentable over Heath in view of Alderson, Marbry and further in view of U.S. Patent No. 6,757,071 to Goodman et al. ("Goodman").

### **REMARKS**

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of November 3, 2005.

Reconsideration of the Application is requested in light of the following comments. Claims 1-11 remain in this application.

#### **A. The Rejection Based on Heath, Alderson and Marbry**

The Examiner rejected claims 1, and 3-10 under 35 U.S.C. §103(a) as being unpatentable over Heath in view of Alderson and Marbry. Applicants respectfully traverse.

Heath is directed to a system and method for automatic application version upgrading. In the process, a client machine calls to the server machine and downloads any new versions of application program components onto the client machine. Heath is specifically directed to application programs, not print drivers.

Marbry, on the other hand, discloses a process for installing printer configuration data and drivers on local workstations when a user attempts to print to a network printer. In response to a request to print to a network printer, printer configuration information is copied to the workstation. This configuration information is then used to print the print job.

Unlike Heath, Marbry does not deal with the updating of programs or program components. Rather, it deals merely with the downloading of printer configuration information necessary to execute a print job. There is no comparison of various versions of a print driver by the workstation, nor the deleting of old versions.

Alderson, on the other hand, deals with a data processing network including a

plurality of workstations connected to a host processor. The workstations send a signal to the host at designated times indicating the version of certain programs they contain. The host then determines if the workstations have the latest version and, if not, sends a copy of the new file to replace the version on the workstations. Thus, it is the host which compares the versions and uploads newer versions of the programs to the workstations, rather than the workstations themselves.

First, there is no motivation to combine Heath with either Alderson or Marbry. To properly combine references under §103, there must be some suggestion to combine the prior art references and a reasonable expectation of success. *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 56 USPQ2d 1456 (Fed. Cir. 2000). In making this determination, “the claimed invention must be considered as a whole, multiple cited prior art references must suggest the desirability of being combined, and the references must be viewed without the benefit of hindsight afforded by the disclosure.” *In re Paulsen*, 31 USPQ2d 1671 (Fed. Cir. 1994). In this respect, prior art references must be considered in their entirety, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1985). Here, there is no motivation to combine the teachings of the references. In fact, when considered in their entirety, the references actually teach away from such a combination.

One skilled in the art practicing the invention of Heath would not be motivated to use the teachings disclosed in Marbry or Alderson since these relate to different processes, and there is no indication that these teachings would be suitable for use therein. That is, as detailed above, Heath relates to the client initiated and conducted updating of application programs, while Marbry relates to the downloading of print configuration data that was not previously stored on a client workstation (i.e. not an updating process), while Alderson relates to the server initiated and conducted process of updating programs on client workstations.

As is well understood, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 123 USPQ 349 (CCPA 1959). Here, that is exactly what the Examiner is proposing – changing the principle of operation of the references in an attempt to meet the recitations of the present claims. That is, Applicants submit that any proposed combination of Heath with Alderson and Marbry would inevitably change

the principle of operation of the inventions.

Finally, in support of his rejection, the Examiner states that such a combination modifying Heath would have been obvious because "(a) it would have expand[ed] the use of Heath to create a bigger market, (b) it would have benefit[ed] the printer driver update process in the Internet environment...and (c) it would have reduced the server processor power for updating clients' printer driver." Assuming these assertions are correct, these are actually reasons why such a combination is NOT obvious. A well known secondary consideration of obviousness is whether there is a long-felt need for the invention. *Ecolochem, Inc. v. Southern California Edison Co.*, 56 USPQ2d 1065 (Fed. Cir. 2000). Here, the Examiner is admitting that such an invention would have filled such a need in the printer driver update industry. Thus, the fact that the Applicant is the first to invent such a process is an indication of its non-obviousness.

Thus, the proposed combination is impermissible and does not present a prima facie case of obviousness.

#### **B. The Rejection of Claims 2 and 11**

Claim 2 was rejected as being unpatentable over Heath in view of Alderson, Marbry and further in view of Davis. Claim 11 was rejected as being unpatentable over Heath in view of Alderson, Marbry and further in view of Goodman.

The Examiner cites Davis for the proposition that in the field of installing software, it is known to read the initialization file of a driver to determine its version. Even assuming this is true, as detailed above, the proposed combination of Heath with Alderson and/or Davis is improper.

Likewise, the Examiner cites Goodman as disclosing that printing using xerographic print system requires a printer driver. Even assuming this is true, as detailed above, the proposed combination of Heath with Alderson and/or Davis is improper.

Thus, applicants submit that the proposed combinations fail to render the present claims unpatentable.

#### **CONCLUSION**

For the reasons detailed above, it is submitted all claims remaining in the application (Claims 1-11) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

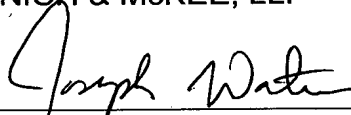
No additional fee is believed to be required for this Response. However, the

undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Mark Svat, at Telephone Number (216) 861-5582.

Respectfully submitted,

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Date

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